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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 17

Application Number: 09/598,110

Filing Date: June 21, 2000

Appellant(s): PULLARO, TERRY

Bryan K. Wheelock
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For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed January 7, 2003.

(1) Real Party in Interest

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is substantially correct, however, inasmuch as the prior art rejections based upon Stoneburner ('525) and Hill ('715) are hereby withdrawn to simplify the issues on appeal, many of the issues enumerated by appellant are no longer before the Board of Appeals and Patent Interferences.

(7) *Grouping of Claims*

Appellant's brief includes a statement that claims 2-17 do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

(8) *ClaimsAppealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) *Prior Art of Record*

2,884,816	Lay	05-1959
5,215,307	Huffman	06-1993
4,444,396	Wendt	04-1984
6,138,879	Breuner	10-2000
5,312,308	Hamilton et al.	05-1994

OFFICIAL NOTICE was taken in the previous action in which is now admitted prior art.

The labeling of the admitted prior thus does not change the rejection set forth in the previous office action.

(10) *Grounds of Rejection*

In order to determine whether application claims must be found unpatentable over the prior, the terms and phrase used in the claims must read in light of the specification. This is necessary to establish whether the meaning of those terms and phrases given by the applicant in the context of the application should be accorded any meaning different from the usual and customary meaning of the claim terms. Here, it is submitted that most of the claim terms, such as "weight", "mass", and "length", must be given their intrinsic dictionary definition. But some other terms such as "sport specific training and conditioning device", "grip portion", and "handle" require some scrutiny. A careful review of the specification as filed and especially page 1, lines 16-27, makes it clear that applicant intends a sport specific training and conditioning device to consist of a handle with a weight at the end. The handle is "shaped like" the sport implement

although it can be up to 30% larger as stated on the next page. The grip portion is the graspable portion of the handle.

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 102

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

1. Claims 2, 3, 9-13 and 17 are rejected under 35 U.S.C. 102(b) as being anticipated by Lay (USPN 2884816).

Lay discloses a claw hammer having a 16-ounce head (10) attached to a shank (12) having a grip portion (34) (See Figures 1 and 2; Column 4, lines 63 through 70; and Column 1, lines 1 through 33). It discloses that the claw hammer is of standard dimensions having a shank of 13 inches and has a spread across the head portion of 5 $\frac{1}{2}$ inches (See Column 4, lines 63 through 70). Because the shank is 13 inches and spreads across the head portion by 5 $\frac{1}{2}$ inches, it would inherently have a center of mass less than 13 inches from the end of the shank. It is submitted that the grip portion of Lay is clearly "shaped like" the grip of many sports implements, like a tennis racket.

2. Claims 2 and 17 are rejected under 35 U.S.C. 102(b) as being anticipated by Huffman (USPN 5215307).

Huffman discloses a swing training exercise device, which can be used by golfers, tennis players, or baseball players, to strengthen specific muscles (See Background of the Invention and Abstract). The device comprises a grip portion, for the specific desired sport; and counter balancing or weights threadably connected, in which length varies with the weight (See Summary of the Invention). The total length of the

exercise device is between 15 to 30 inches (See Summary of the Invention). The device would inherently have a center of mass within 13 inches of the end of the handle, when factoring in the length of the weights attached to the ends, especially if the 15 inch version is evaluated.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

3. Claims 4, 5 and 9-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lay (USPN 2884816) in view of admitted prior art.

Lay does not disclose a specific diameter or length for the head. It is admitted prior art that tool dimensions are variable such as for use in tight spaces and in addition that the center of mass is dependent upon weight, shape, and size. Shortening the handle, increasing the weight, or changing the shape of the head would inherently move the center of mass. It would have been obvious to one having ordinary skill in the art at the time the invention was made to make the hammer head of Lay have a diameter and length of any amount desirable including less than about 4 inches to provide a smaller length hammer. It also would have been obvious with respect to claims 14 and 15 to shorten the handle, particularly to less than 10 inches, to provide a hammer for use in tight spaces or for use by housewives, as taught by the admitted prior art, which would

inherently create a center of mass point, or balancing point, desired by the designer and user. With respect to claims 9-13, the handle is shaped like a bat, golf club, tennis racket, and hockey stick because it resembles such handles.

4. Claims 2-5 and 7-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Breuner (USPN 6138879) in view of admitted prior art.

Breuner discloses a mallet tool for creating proper pocket formation in athletic ball catching gloves having a handle attached to a sports ball, or head (See Abstract). The handle has a length of 6 to 12 inches from where the handle meets the head and may be styled and dimensioned like that of the handle of a youth baseball bat (See Summary of the Invention; and Column 2, lines 45 through 50). The head is configured to look and feel like a regulation ball, such as a 3-inch diameter baseball, and can be threadably attached to the handle (See Column 2, lines 33 through 44; and Column 3, lines 12 through 31). The device inherently has a center of mass less than 13 inches from the end of the handle. It is admitted prior art that tool dimensions may be varied based upon the user's design consideration and that the center of mass is dependent upon weight, shape, and size. Shortening the handle, increasing the weight, or changing the shape of the head would inherently move the center of mass. It would have been obvious to one having ordinary skill in the art at the time the invention was made to shorten the handle, particularly to less than 10 inches, as taught by the admitted prior art in order to obtain a center of mass point, or balancing point, desired by the user. With respect to claims 9-13, note that the reference handle may resemble a bat, golf club, tennis racket, and hockey stick.

5. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Breuner (USPN 6138879) in view of Wendt (USPN 4444396).

Breuner does not disclose the device weighing more than a regulation sporting device. Wendt discloses a weighted golf swing exercise club in which weighs more than the regulation golf club to enable the user to strengthen his/her muscles used for golf (See Column 2, lines 36 through 60). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to make the device of Breuner weigh more than the regulation sporting device, in order to strengthen the user's muscles used for a sport.

6. Claims 2-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hamilton et al. (USPN 5312308) in view of Huffman (USPN 5215307).

Hamilton et al. discloses a forearm apparatus to exercise the forearm muscles (See Summary of the Invention). The apparatus includes an elongated handle and plurality of weighted rings on the end of the handle (See Summary of the Invention). It is noted that the apparatus has optimum dimensional relationships for the parts of the invention, which include variations in size, material, shape, form, function and manner of operation, assembly and use (See Column 4, lines 3 through 11). Therefore, since Hamilton et al. discloses an invention with the same parts and the same purpose, the routine optimization of the dimensions and center of mass of the device would have been obvious because there is no indication of which parameters are critical or no direction as to which of many possible choices is likely to be successful. (See MPEP 2123 and Merck & Co. Inc. v. Biocraft Laboratories Inc., 10 USPQ2d 1843). Hamilton et

al. does disclose the grips of various sport implements. Huffman discloses a swing training exercise device, which can be used by golfers, tennis players, or baseball players, to strengthen specific muscles (See Background of the Invention and Abstract). The device comprises a grip portion, for the specific desired sport; and counter balancing or weights threadably connected, in which length varies with the weight (See Summary of the Invention). The total length of the exercise device is between 15 to 30 inches (See Summary of the Invention). It would have been obvious to one having ordinary skill in the art at the time the invention was made, in view of Huffman, to make the length of the Hamilton device of about 15 inches to reduce the size, which would inherently make the center of mass 13 inches or less.

(11) Response to Argument

The present invention is a sports and training and conditioning device in which strengthens the user's forearms. The device comprises a handle having a grip portion and a weight attached the end of the handle wherein the handle is shaped like the grip portion of an implement. The sport in which the device is to be used may be varied. The handle is 6 to 18 inches long, in which the weight attached to the handle gives the device a center of mass at most at 13 inches away from the gripping end of the handle. The present invention also discloses having a weight heavier than the implement used in the sport.

The following references and their teaching used to reject claims 2-17 are as follows:

Lay (USPN 2884816) discloses a hammer comprising a handle having a grip and a claw head, which is inherently weighted.

Huffman (USPN 5215307) discloses a golf swing training exercise device having a shaft with a grip having the shape of a golf club, tennis racket, or baseball bat grip and a weight attached to the ends of the shaft.

Wendt discloses a weighted golf swing exercise device in which the device weighs more than the regulation golf club.

Breuner (USPN 6138879) discloses a mallet tool for teaching the proper way to pocket a baseball within a glove. The device has a handle shaped like a baseball bat and a baseball in which is threadably attached to the handle.

Hamilton et al. discloses a forearm exercise device having a handle with a grip portion and weights attached thereto.

It is noted that the OFFICIAL NOTICE taken in the office action dated May 6, 2002 has been acknowledged as admitted prior art and thus does not change any rejection.

The appellant argues in the appeal brief that prima-facie anticipation and obviousness has not been established and argues that an implement used for sports is not disclosed by any of the references above. The examiner respectfully disagrees.

"Question whether reference is analogous art is irrelevant to whether that reference anticipates claimed invention; reference may be from entirely different field of endeavor from that of claimed invention or may be directed to entirely different problem from that addressed by the inventor, yet reference will still anticipate if it explicitly or inherently discloses every limitation recited in claims."

In re Schreiber, CAFC 44 USPQ2d 1429

Lay discloses a hand held implement, a hammer, having a handle and a head, which is inherently weighted. Huffman also disclose a handheld implement, a golf swing training device, having a handle and a weight attached to the handle. If a prior art structure is capable of performing the intended use as recited in the preamble, then it meets the claim (See *In re Schreiber*, CAFC 44 USPQ2d 1429). Both Lay and Huffman are capable of performing the intended use recited by the appellant in claims 2, 3, 9-13, 15 and 17. Though the prior art is from a different endeavor and solves a different problem, it anticipates the above claims.

In regards to claims 4, 5, and 9-17, appellant argues that Lay in view of the OFFICIAL NOTICE, which is now admitted prior art, is not obvious because Lay is a hammer. The examiner disagrees for the above reasons. Furthermore, to establish obviousness a) the claimed invention must be considered as a whole, b) the references must be considered as a whole and must suggest the desirability and thus obviousness of making the consideration; c) the references must be viewed without the benefit of impermissible hindsight vision afforded by the claimed invention; and d) reasonable expectation of success is the standard with which obviousness is determined. The suggestions of the admitted prior art were not disputed by the appellant, therefore, it is submitted that prima-facie obviousness has been established because the arguments with respect to claims 4, 5, and 9-17 were directed to Lay.

In regards to claims 2-5 and 7-14 rejected under Breuner and OFFICIAL NOTICE, which is now admitted prior art, the appellant does not dispute the combination, therefore, it is submitted that prima facie obviousness has been

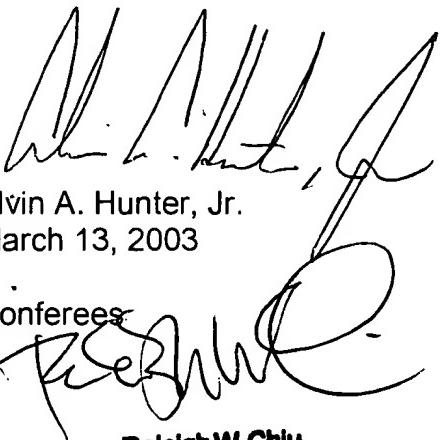
established. It should be noted that Breuner may well anticipate a number of claims and is also capable of being used for the appellant's intended purpose.

In regards to claims 6, rejected under Breuner, OFFICIAL NOTICE, which is now admitted prior art, and Wendt, the applicant argues that neither Breuner nor Wendt show a device having a handle of a sport implement nor teaches a device weighing more than the standard implement in the sport. The examiner respectfully disagrees. Breuner as noted in the rejection above, clearly discloses that the handle is of the shape of a baseball bat, a sport implement, and Wendt clearly discloses that the grip of the device may be that of a golf club. Breuner teaches that the length of the handle is 6 to 12 inches and the head is a regulation sports ball. A regulation baseball weighs 5 to 5 ½ ounces. Based on the length of the handle the center of mass can reside anywhere along the device as noted by the admitted prior art used in claim 2. Furthermore, Wendt clearly discloses that the device weighs more than the actual regulation golf club for the purpose of strengthening muscles. One would have clearly been motivated to make the device heavier than the regulation implement in order to further strengthen muscles. Wendt was only used to suggest why one would make the invention of Breuner heavier. The biomechanical effect is not seen to be different. For these reasons, it is believed that prima facie obviousness has been established.

In regards to claims 2-14 rejected under Hamilton et al. in view of Huffman, the appellant argues that neither Hamilton et al. nor Huffman shows or teaches a handle having the grip portion of a sport implement, a center of mass less than 13 inches from the first end of the handle, shaped like the a bat, racket, golf club, or hockey stick. The

examiner disagrees. It should be pointed out that none of the appellant's claims does not restrict a weight from being on both ends of the handle. Hamilton et al. discloses a forearm training device comprises a shaft with a grip and a weight attached to the end of the grip. Hamilton et al. notes that the dimensions of the invention may be varied. Huffman discloses a golf swing exercise device having weights on both ends of the shaft. The length of the Huffman device is between 15 to 30 inches. It is apparent that if the weights on both ends of the shaft are equal the center of mass would be in the center of the device which is anywhere from 7 ½ inches to 15 inches from an end of the shaft, therefore, clearly making the location of the center of mass clear. Huffman further discloses that the grip on the shaft may resemble a golf club, tennis racket, or baseball (See Column 2). The Huffman device clearly teaches the use of different grips and therefore, would have clearly been obvious to have the combination have a grip of any implement. It is apparent that both references show and teach the desirability of the present invention and establishes *prima facie* obviousness.

For the above reasons, it is believed that the rejections should be sustained.



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March 13, 2003

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